

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: March 14, 2023

Mailed: July 14, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Audemars Piguet Holding, S.A.

v.

Haas Outdoors, Inc.

—
Opposition Nos. 91242213 (parent) and 91242238
—

John A. Galbreath of Galbreath Law Offices PC
for Audemars Piguet, S.A.

W. Whitaker Rayner of Jones Walker LLP,
for Haas Outdoors, Inc.

—
Before Wellington, Pologeorgis, and Dunn, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Haas Outdoors, Inc. (“Applicant”) filed applications seeking to register the marks



MOSSY OAK (in standard characters) and **MOSSY OAK** on the Principal Register
for use on “jewelry; watches” in International Class 14.¹

¹ Application Serial Nos. 87821623 (standard character mark) and 87821622 (composite word and design mark) were filed on March 6, 2018; the applications are based on allegations that the marks were first used in commerce on August 26, 2009, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The latter, composite mark is described as “consist[ing] of the wording ‘MOSSY OAK’ below a tree in an oval.”

Audemars Piguet Holding, S.A. (“Opposer”) filed a notice of opposition against each of Applicant’s marks, opposing registration of each mark under Section 2(d) of the Trademark Act (“the Act”), 15 U.S.C. § 1052(d), on the ground that Applicant’s marks are likely to cause confusion with Opposer’s pleaded registered marks identified below:

ROYAL OAK (in standard characters) for:

Horological and chronometric instruments, namely, watch cases, watch bands, chronographs for use as watches, clocks, watches, wristwatches, in International Class 14;² and

Royal Oak for:

Watches and clocks and parts thereof, in International Class 14.³

Opposer also opposes registration of Applicant’s marks on the ground of dilution by blurring or by tarnishment under Section 43(c) of the Act. 15 U.S.C. §§ 1052(d) and 1125(c). In support of this claim, Opposer alleges that its registered marks have been famous since at least as early as Applicant’s filing date or first use of its marks.

Applicant, in its Answers, denies the salient allegations of the Notices of Opposition.

² Registration No. 2885834 (hereinafter “Reg. No. ’834”) issued September 21, 2004; renewed.

³ Registration No. 965112 (hereinafter “Reg. No. ’112”) issued July 31, 1973; renewed.

The two opposition proceedings were consolidated by the Board, and the parties were instructed to file all papers in the “parent” proceeding, Opposition No. 91242213.⁴ The case is fully briefed, and an oral hearing was held on March 14, 2023.

For the reasons explained below, we sustain the oppositions solely on the ground of likelihood of confusion, and dismiss the oppositions on the ground of dilution.

I. Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of Applicant’s involved applications. In addition, because Opposer filed copies of its pleaded registrations, obtained from the USPTO electronic and showing status and title, these are also of record. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1).

At trial, Opposer introduced:

- First Notice of Reliance on Internet printouts;⁵
- Second Notice of Reliance on the transcripts of the Fed. R. Civ. Pro. 30(b)(6) discovery deposition testimony of Applicant, through its designated witnesses: Jesse Raley and Cindy Reed, with exhibits;⁶
- Third Notice of Reliance on Applicant’s responses to Opposer’s interrogatories;⁷

⁴ See 8 TTABVUE (Board consolidation order). Accordingly, citations to the record and briefs are made to TTABVUE, the Board's online docket system, for Opposition No. 91242213. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, *2 n.1 (TTAB 2020).

In citing to this docket, the number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

⁵ 75 TTABVUE.

⁶ 76 TTABVUE; 77 TTABVUE (exhibits designated “confidential”).

⁷ 78 TTABVUE; 79 (materials designated “confidential”).

- Fourth Notice of Reliance on Internet printouts;⁸
- Testimony Declaration of Sarah Morellon, Opposer’s Senior IP Counsel, and accompanying exhibits;⁹
- Fifth Notice of Reliance on Internet printouts;¹⁰
- Testimony deposition transcript of William Rohr, Opposer’s expert witness, and accompanying exhibits;¹¹ and
- Testimony deposition transcript of Stephen Pulvirent, Opposer’s expert witness, and accompanying exhibits.¹²

Applicant introduced:

- Testimony Declaration of John McKie, a former Research and Direct Marketing Officer for a marketing communications firm, and accompanying exhibits, including a survey;¹³
- Testimony Declaration of Ben Maki, Applicant’s Chief Marketing Officer, and accompanying exhibits;¹⁴
- Testimony Declaration of Cindy Reed, Applicant’s Operations Manager, Licensing, and accompanying exhibits;¹⁵ Opposer elected to cross-examine Ms. Reed and submitted the cross-examination testimony transcript, with exhibits, at a later date;¹⁶
- First Notice of Reliance on copies of third-party registrations and lists for registrations for OAK marks;¹⁷

⁸ 80 TTABVUE.

⁹ 81-86 TTABVUE; 87 TTABVUE (exhibits designated “confidential”).

¹⁰ 89 TTABVUE.

¹¹ 92-93 TTABVUE.

¹² 94-95 TTABVUE.

¹³ 96 TTABVUE.

¹⁴ 97-100 TTABVUE.

¹⁵ 101 TTABVUE.

¹⁶ 110-111, 113 TTABVUE.

¹⁷ 103-104 TTABVUE.

- Second Notice of Reliance on Opposer's responses to Applicant's interrogatories;¹⁸ and
- Third Notice of Reliance on excerpts from book and Internet printouts.¹⁹

On rebuttal, Opposer introduced:

- Cross-examination testimony transcript, and accompanying exhibits, of John McKie;²⁰
- Sixth Notice of Reliance on Internet printouts from Applicant's and third-party websites;²¹
- Seventh Notice of Reliance on Internet printouts from third-party websites;²²
- Cross-examination testimony transcript of Ben Maki, with exhibits;²³
- (Rebuttal) testimony deposition transcript of Stephen Pulvirent, with exhibits;²⁴ and
- (Rebuttal) testimony deposition transcript of William Rohr, with exhibits.²⁵

Evidentiary Objections

Opposer objects to Applicant's introduction of an exhibit during its cross-examination of Opposer's expert witness, Mr. Rohr, and Applicant's questions

¹⁸ 105 TTABVUE; 106 TTABVUE (materials designated "confidential").

¹⁹ 107 TTABVUE.

²⁰ 114 TTABVUE.

²¹ 115-116 TTABVUE.

²² 117 TTABVUE.

²³ 118-119 TTABVUE.

²⁴ 120-124 TTABVUE.

²⁵ 125-128 TTABVUE.

regarding the exhibit.²⁶ Specifically, Opposer contends that the questioning and exhibit involve “[t]hird-party marks [which] were not discussed, or even mentioned, anywhere in Mr. Rohr’s direct testimony – and thus, applicant’s questions and exhibit concerning third-party marks are outside the scope of Mr. Rohr’s direct testimony,”²⁷ citing Fed. R. Evid. 611(b) (“Scope of Cross-Examination. Cross-examination should not go beyond the subject matter of the direct examination and matters affecting the witness’s credibility.”)

Applicant responded to Opposer’s objection, and raised four objections to certain evidentiary submissions from Opposer.²⁸ Specifically, Applicant objects to Opposer’s introduction of: (1) evidence regarding “survey sample size calculators” on the basis hearsay and lack of foundation;²⁹ (2) “documents identifying various trees and leaves incorporated into certain limited edition watches of Opposer” on the bases that they were not timely produced in response to discovery requests, lack of foundation, and relevance;³⁰ (3) the testimony of Opposer’s expert witnesses, Mssrs. Rohr and Pulvirent, on the bases of “competency, foundation, [and] relevance”;³¹ and (4)

²⁶ 129 TTABVUE 53-54 (objection). The objected-to material is located at 127 TTABUE (Rohr (rebuttal) Dep. Ex. 43).

²⁷ *Id.*

²⁸ 130 TTABVUE 56-61.

²⁹ Applicant objects to Opposer’s submissions at 117 TTABVUE 5-87.

³⁰ Applicant objects to Opposer’s submissions at 89 TTABVUE 1-39.

³¹ 130 TTABVUE 60; Applicant does explicitly state that it objects to the entire testimony, but argues that “Opposer’s sole experts are members of the watch industry, whose expertise, if any, limits them to testimony concerning the niche market of the watch industry. Neither witness has experience in brand awareness or surveys.” *Id.*

testimony and a related exhibit involving “supposed search results showing ROYAL OAK and MOSSY OAK listed together, along with numerous other products,” on the bases that these materials were not produced in response to discovery requests, “estoppel, [and] timeliness.”³²

In general, we note that much of the parties’ objections are based on relevance or lack of probative value and, in this regard, we point out that Board proceedings are heard by Administrative Trademark Judges, not lay jurors who might easily be misled, confused, or prejudiced by irrelevant evidence. *Cf. Harris v. Rivera*, 454 U.S. 339, 346 (1981) (“In bench trials, judges routinely hear inadmissible evidence that they are presumed to ignore when making decisions.”).³³ In this capacity, “the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. With respect to the objections based on the lack of probative value or hearsay, the Board is able to weigh all evidence and testimony appropriately, and we see no need to exclude it outright. Thus, we have considered the evidence, keeping in mind the objections, and have accorded whatever probative

³² 130 TTABVUE 61; Applicant refers to Maki Dep. 71:7-91:22 and Maki Ex. 5 (118 TTABVUE).

³³ With respect to the objections that Opposer failed to lay a foundation for specific evidence, these are procedural and must be raised promptly to allow the opportunity for a cure. *See Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400 at *4 (TTAB 2020); *The Wet Seal, Inc. v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1637 n. 16 (TTAB 2007). To the extent that the foundation objections were raised for the first time in Applicant’s trial brief, they are waived as untimely. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241 (TTAB 2021); *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 846 (TTAB 1984).

value the testimony and evidence merits.” *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006). *See also Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017).

Specifically, we decline to strike the cross-examination testimony of Mr. Rohr, or the related exhibit, regarding putative third-party use of similar marks.³⁴ Similarly, we need not strike the testimony of Opposer’s expert witnesses, particularly their testimony to an alleged degree of fame amongst the general public based on personal interactions with other individuals, nor do we need to strike Opposer’s submission of materials with the Maki deposition, or the related testimony, involving search engine results leading to confusion. Rather, we accord this evidence the weight, if any, it deserves. To the extent we rely on any of the objected-to testimony and documents, we keep in mind its deficiencies.

Therefore, we overrule the parties’ objections, but will weigh the relevance, if any, of all evidence and its strength or weakness, including any inherent limitations therein.

II. Opposer’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)).

³⁴ We hasten to add that the objected-to exhibit comprises printouts that were all submitted separately as an exhibit with the Reed Dec. (101 TTABVUE, Reed. Ex. E).

A party in the position of plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer's pleaded registrations, particularly Reg. No. '834 for the mark ROYAL OAK in standard characters, which is of record, establishes that Opposer is entitled to oppose registration of Applicant's marks on the ground of likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (registration establishes "standing"); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).³⁵

Applicant does not contest Opposer's entitlement to a statutory cause of action in these consolidated proceedings.

³⁵ Our finding of Opposer's entitlement to bring its likelihood of confusion claim means that it is also entitled to bring its dilution claim. *See, e.g., Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once entitlement is shown on one ground, plaintiff has right to assert any other ground in proceeding).

III. Priority

Because Applicant has not counterclaimed to cancel Opposer's pleaded registrations, priority is not at issue with respect to these registered marks and the goods identified in these registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

IV. Likelihood of Confusion -- Analysis

Opposer bears the burden of proving a likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf*, 55 USPQ2d at 1848.

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth "DuPont" factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."). We consider the likelihood of confusion factors about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

In making our likelihood of confusion analysis, we focus on Opposer's pleaded Reg. No. '834 for the standard character ROYAL OAK mark. It bears a closer resemblance

to both Applicant's standard character and composite and design marks than the other pleaded mark and covers "watches" that, as discussed *infra*, are listed in both Applicant's applications. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010). If we would not decide in Opposer's favor as to its likelihood of confusion claim based on its Reg. No. '834, we would not decide in its favor based on the other pleaded registration.

A. Identity of Goods; Trade Channels and Classes of Consumers

We begin our analysis with the *DuPont* factor involving the "similarity or dissimilarity and nature of the goods or services as described in an application or registration." *DuPont*, 177 USPQ at 567; *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Concurrently, we also assess the *DuPont* factor involving "the similarity or dissimilarity of established, likely-to-continue trade channels" for the involved goods, *DuPont*, 177 USPQ at 567, and the classes of consumers of the goods.

Because the involved applications' identifications of goods include "watches" and Opposer's goods, as identified in Reg. No. '834, also include "watches," the parties' goods are identical in part.

In addition, because there are no limitations with respect to the types of consumers or channels of trade for the parties' watches, we must presume that these goods move in the same ordinary channels of trade and are sold to the same ordinary classes of consumers for watches. *Narita Export LLC v. Adaptrend, Inc.*, 2022

USPQ2d 857, at *17 (TTAB 2022) (“Respondent’s unrestricted identification of goods is not limited by channels of trade, Respondent’s goods are presumed to travel in all ordinary channels of trade which include Petitioner’s proven channel of trade”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (although no trade channel presumptions attach to common law mark for beer, Board noted that “there are no restrictions or limitations in Applicant’s description of goods” and presumed “that Applicant’s beer will move in all channels of trade normal for such goods ... including Opposer’s trade channels”). To be clear, and relevant to our ultimate likelihood of confusion determination, we must assume that both parties’ watches are offered to all consumers for all types of watches, i.e., from those seeking to purchase an inexpensive, ordinary watch to those seeking to buy an extremely expensive, luxury watch.

Accordingly, the *DuPont* factors involving the relatedness of the parties’ goods and their channels of trade and classes of purchasers weigh strongly in favor of finding a likelihood of confusion.

B. Alleged Strength and Weakness of Opposer’s Mark

Before we make our comparison of the marks, we consider the strength, including any fame, as well as any weakness of Opposer’s ROYAL OAK mark. We do so because a determination of the strength or weakness of this mark helps inform us as to its scope of protection. In doing so, we consider the fifth *DuPont* factor which enables Opposer to expand the scope of protection that should be given to its mark through evidence showing “[t]he fame of the prior mark (sales, advertising, length of use).”

DuPont, 177 USPQ at 567. We also consider the sixth *DuPont* factor which allows Applicant to contract the scope of protection of Opposer's mark by adducing evidence of third-party use of similar marks on similar goods. *Id.*

When evaluating the strength or weakness of a mark, we look at the mark's inherent strength based on the nature of the term itself and its commercial strength in the marketplace, *Spireon Inc. v. Flex Ltd.*, 2023 USPQ2d 737, at *4 (Fed. Cir. 2023), citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength), as well as "[t]he number and nature of similar marks in use on similar goods." *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *17 (TTAB 2022) (quoting *DuPont*, 177 USPQ at 567). *See also New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596 at *10 (TTAB 2020); *In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength ... and its marketplace strength ..."). "[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak." *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003). *See also Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017).

1. Conceptual Strength of the ROYAL OAK Mark on Watches

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Spireon*, at *4 (quoting *Two Pesos, Inc. v.*

Taco Cabana, Inc., 505 U.S. 763, 768 (1992)). Because Opposer’s Reg. No. ’834 is on the Principal Register, without a claim of acquired distinctiveness, the mark ROYAL OAK is presumed to be inherently distinctive for those goods. Trademark Act Section 7(b), 15 U.S.C. 1057(b); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006) (a “mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods”). In other words, ROYAL OAK must, at least, be suggestive because “marks that are merely descriptive cannot be registered unless they acquire secondary meaning under § 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), but marks that are suggestive are ‘inherently distinctive’ and can be registered.” *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017).

Nevertheless, ROYAL OAK may be weak if it is shown to be highly suggestive. *See Spireon*, at *4 (“highly suggestive [marks] are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts”) (citations omitted). On the other hand, “the fact that a mark may be somewhat suggestive does not mean that it is a ‘weak’ mark entitled to a limited scope of protection.” *In re Great Lakes Canning, Inc.*, 227 USPQ 483, 485 (TTAB 1985).

Applicant does not argue that the entire ROYAL OAK mark is conceptually or inherently weak, or that the term ROYAL OAK has a recognized meaning beyond the meaning of the separate words ROYAL and OAK. In the context of arguing

dissimilarity of the marks, however, Applicant asserts that ROYAL conjures a “regal, expensive ... stately ... atmosphere.”³⁶ We agree that this term, ROYAL, is somewhat suggestive and, in the context of the goods, may evoke an expensive or stylish watch. As for the term OAK, the evidence shows a third party advertising watches that are made of wood.³⁷ However, this evidence does not specify that the wood watches are made of oak, and neither Applicant nor Opposer assert that their watches are, or will be, made of wood. We do not find the evidence that wood watches exist establishes that the term for any types of wood, including OAK, will be perceived by the relevant consumers as suggesting the material composition of watches.

Even if the term “royal,” and arguably “oak,” can be characterized as suggestive of watches, this does not mean that ROYAL OAK, as a whole, is also suggestive and so weak as to be limited in its scope of protection. *See In re Carnation Co.*, 196 USPQ 716, 718 (TTAB 1977) (“The fact that the term ‘partner’ [in the mark POTATO PARTNER] may be somewhat suggestive [for food topping] does not necessarily mean that a mark comprised in whole or in part of such term is a ‘weak’ mark entitled to but a limited scope of protection.”). To the contrary, we conclude that Opposer’s entire mark, ROYAL OAK, as used on watches, is arbitrary and thus is a conceptually strong mark.

³⁶ 130 TTABVUE 15.

³⁷ 101 TTABVUE (Reed Dec. Ex. E, showing “Little Oak” online retail outlet advertising “Comfortable, handmade wooden watches.”).

2. Commercial Strength or Weakness of the ROYAL OAK Mark on Watches

Opposer argues that its ROYAL OAK mark is “famous in the United States due to [its] long history of use, significant sales success, extensive advertising and promotion, numerous well-known spokespeople and endorsers, sponsorship of major public events, and frequent mentions in the media.”³⁸ In support, Opposer relies on the testimony of its in-house Senior IP Counsel, Sarah Morellon, and its expert witnesses, William Rohr and Stephen Pulvirent, along with accompanying exhibits. Opposer identifies the following information as probative:

- Length of time: ROYAL OAK watches have been sold in the U.S. since 1972;³⁹
- Sales (2006-2012): Opposer’s sales of ROYAL OAK watches in the U.S. for this period “totaled \$ 339 million,” with \$ 62 million, alone, in 2012.⁴⁰
- Advertisement: Since 1972, Opposer has “spent millions” in advertising ROYAL OAK watches in the U.S., with \$ 750,000 spent in 2012, alone, and advertisements placed in prominent publications, such as Time Magazine, The New York Times, Forbes, Golf Digest, Vanity Fair.⁴¹
- Endorsements: Opposer has engaged famous spokespeople and endorsers to promote its ROYAL OAK watches, including, Arnold Schwarzenegger (since 1999), Jay-Z, Shaquille O’Neal, Rory McIlroy, Lionel Messi and LeBron James.⁴²
- Sponsorship of Public Events: From 2009-2014, Opposer was a sponsor of the Tony Awards and ROYAL OAK watches were “prominently displayed” and

³⁸ 129 TTABVUE 16.

³⁹ 81 TTABVUE (Morellon Dec. ¶¶ 2-3).

⁴⁰ *Id.*, ¶ 5.

⁴¹ *Id.*, ¶¶ 7-9.

⁴² *Id.*, ¶¶ 10-17.

worn by celebrities, and other public events where the ROYAL OAK watch was featured.⁴³

- Unsolicited U.S. Media Attention: various articles, including a 1994 Los Angeles Times article discussing fashionable watches and describing Opposer as “among the leading prestige watch manufacturers”; a 2005 Vanity Fair article discussing “the greatest classic steel watches of the 1970s” and describing “[t]he Royal Oak, launched in 1972, [as] the watch that started it all” and the “world’s first luxury steel sports watch ... the Royal Oak challenged accepted values of luxury-watchmaking”; and a December 2011 The New York Times article describing “Audemars Piguet Royal Oak” as “mak[ing] it onto most collectors’ lists” for “truly classic watches.”⁴⁴

Opposer’s expert witnesses, Mssrs. Rohr and Pulvirent, also testified as to what they believe is the extent of renown for Opposer’s ROYAL OAK mark on watches. Mr. Rohr, who has over 20 years in the watch industry as journalist, designer, consultant, collector, and auctioneer,⁴⁵ testified that ROYAL OAK not only has niche fame in the luxury watch market, but is well-known amongst consumers who may not be able to afford the watch.⁴⁶ In explaining, he likens the ROYAL OAK mark to one for expensive cars:⁴⁷

For example, ... you have hundreds of thousands of people having Ferrari posters in their home, doesn't mean they're going to buy one tomorrow. In general, a lot of people are interested in products that they cannot afford. It's aspirational. Like, they believe that one day they will buy them and have them and motivate them to work and, you know, and produce things.

⁴³ *Id.*, ¶¶ 23-25.

⁴⁴ 86 TTABVUE (Morellon Dec. Exs. 401, 404-405); see Exs. 402-403 and 406-413.

⁴⁵ 125 TTABVUE (Rohr Dep. 12:11-13:20).

⁴⁶ *Id.*; 20:22-21:21.

⁴⁷ *Id.*; 21:23-22:11.

Mr. Pulvirent, a journalist and media professional in the world of luxury watches,⁴⁸ also testified that Opposer's ROYAL OAK mark is famous beyond "merely a niche fame" in the luxury watch brand market:⁴⁹

Royal Oak is one of the most, I would say, recognized and talked about and revered and important watches in all of watches. And I would say anyone who's, you know, kind of in that world is likely to know that mark, to know those products and to have some level of kind of like interest or opinion about them.

... there are sure the collectors and customers, but it's also ordinary people, people, again, who -- who have any reason to kind of be interacting with this. And, you know, this is not, you know, relegated to kind of like industry things, it's -it's much more mainstream than that.

Applicant, on the other hand, contends that the ROYAL OAK mark "is not famous across a wide sector of the United States," and takes issue with much of Opposer's evidence.⁵⁰ Specifically, Applicant argues that "almost none of" Opposer's evidence of sales and advertising "was conducted in the last five years"; that "vast majority of all such marketing ... focused upon is not the individual watch model name, ROYAL OAK, but instead on Opposer's house mark AUDEMARS PIGUET"; that some of publications advertising Opposer's ROYAL OAK watches are "not marketed to the public at large, but specific wealthy individuals who subscribe to niche publications"; and that while Opposer's sales of \$ 170 million may "seem like a large sum, ... the starting price for ROYAL OAK watches is \$20,000 per watch, and go upwards of

⁴⁸ 120 TTABVUE (Pulvirent Dep. 9:14-15).

⁴⁹ *Id.*; 16:14-20.

⁵⁰ 130 TTABVUE 22.

\$100,000, ... [and], even assuming all watches sold during this period were the entry-level model, the dollar volume of sales translates into only 8500 units over a four year period for a total of 2,125 sales per year.”⁵¹ Applicant also attacks the ability of Opposer’s expert witnesses to provide testimony regarding whether ROYAL OAK mark is famous with the general public.

In addition, Applicant relies on the testimony of its own expert, Mr. McKie, who conducted an online survey of approximately respondents, with only 3.4% identifying ROYAL OAK as being used as “either part of [a] company name or as the name of a product or service” for watches.⁵² Applicant argues that this level of brand recognition is “far, far, far less than what is needed to establish fame for likelihood of confusion purposes.”⁵³

Opposer responded to the McKie survey by arguing that it is “flawed, and does not accurately represent the U.S. population.”⁵⁴ Opposer asserts that the number of survey respondents is too small and the demographics, including the age and geographic location of the respondents, do not “accurately represent the U.S. population.”⁵⁵ In addition, Opposer argues the survey is “flawed” in its design because

⁵¹ *Id.* at 22-24.

⁵² 96 TTABVUE.

⁵³ 130 TTABVUE 32.

⁵⁴ 129 TTABVUE 30.

⁵⁵ *Id.* at 30-38.

it does not include “any other famous watches” which would have provided some “perspective on what brand awareness would typically be for a famous watch.”⁵⁶

Applicant also relies on evidence it submitted showing approximately five different third-party uses of marks containing the term OAK on or in connection with watches.⁵⁷ This evidence, comprising nine pages of website printouts, showing the following marks used on or in connection with watches: OAK & OSCAR; LITTLE OAK; BLACK OAK; FRANK AND OAK; and OAK & JACKAL. In addition, although Applicant points to several applications and registrations, only one is a live registered mark that covers “watches” and incorporates the term OAK:⁵⁸



Applicant argues that the third-party use and registration evidence “place[s] the term [OAK] in a crowded market” and the “public is unlikely to associate the term ‘oak’ with only one manufacturer, supplier, or distributor of watches or jewelry.”⁵⁹

⁵⁶ *Id.* at 38.

⁵⁷ 130 TTABVUE 36; referencing Reed Declaration and accompanying exhibits at 101 TTABVUE 5-6 (Internet printouts attached at Reed Ex. E).

⁵⁸ Reg. No. 5622950 issued on December 4, 2018; printout of the registration is attached at 103 TTABVUE (Applicant’s First NOR, Ex. B).

⁵⁹ 130 TTABVUE 40.

Indeed, Applicant asserts that the watch market is “replete with third parties who use the term ‘oak’ in connection with the sale and marketing of watch and jewelry products.”⁶⁰

Opposer disputes the probative value of Applicant’s third-party use and registration evidence, arguing:⁶¹

there is absolutely no evidence that [Applicant] can point to about the extent of these supposed third-party uses. There is no evidence regarding the extent of sales or promotional efforts surrounding the supposed uses, and it is unknown what impact, if any, the supposed uses have had in the minds of the purchasing public.

Based on the parties’ arguments and upon evaluating the entire record, including evidence not specifically mentioned, we conclude that ROYAL OAK is an extremely well-known mark in connection with luxury watches. Evidence that we find particularly probative with regard to the commercial strength and renown of ROYAL OAK in connection with luxury brand segment of the watch market is the unsolicited media attention, including newspaper and magazine articles, reflecting an understanding that Opposer’s ROYAL OAK watches are regarded by collectors and aficionados as the “world’s first luxury steel sports watch” or as one of a few “truly classic watches” amongst other luxury brands. The testimony of Opposer’s expert witnesses, along with related exhibits, further corroborates the commercial strength of the mark in the luxury watch market.

⁶⁰ 130 TTABVUE 36.

⁶¹ 131 TTABVUE 11.

Although the record shows that Opposer has gone through great efforts to promote its ROYAL OAK mark to the general public, we find the mark's level of prominence or fame in the luxury watch market does not extend to the general public.⁶² Rather, we just find the mark to be commercially strong. In particular, although Opposer's expert witnesses testified that the "fame" of the ROYAL OAK mark on watches goes beyond the luxury watch market into the mainstream public knowledge, their underlying basis for making this conclusion is lacking. That is, we agree with Applicant that reliance by Mssrs. Rohr and Pulvirent on their personal experiences and interactions with individuals equates to their conclusions being anecdotal and not based on real data. Also neither witness has experience with brand recognition surveys.

In terms of Applicant's contention that ROYAL OAK is commercially weak, we disagree. Applicant's third-party uses and registrations showing marks containing the term OAK in connection with watches are minimal in number, i.e., the website printouts showing five different marks with the term OAK and a single registration for a mark incorporating the term for watches. Even assuming that these marks are

⁶² A threshold element for the dilution claim is the requirement that the plaintiff's mark is "famous," meaning that the mark "is widely recognized by the general consuming public of the United States as a designation of source for the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A). Accordingly, in view of our finding that ROYAL OAK is not widely known amongst the general consuming public, Opposer's dilution claim necessarily fails. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012). To be clear, "niche fame" does not satisfy this element for a dilution claim because the "general consuming public" is the benchmark audience. *Coach Servs.*, 101 USPQ2d at 1372.

actually being used on or in connection with watches, these are too few and there is too little information to support a finding that consumers may have become so accustomed to encountering these marks in commerce that they are now conditioned to overlook any similarity in marks containing the term OAK. Indeed, “[t]he purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of ... similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

In sum, we find Opposer’s ROYAL OAK mark is a conceptually strong mark. It is also commercially extremely strong and may even be characterized as having niche fame in the luxury brand segment of the watch market. However, that level of strength for the mark is not present in the overall watch market. Amongst the general purchasing public for watches, the ROYAL OAK mark is not an especially strong or weak mark, but deserves a normal scope of protection.

We weigh the aforementioned findings accordingly in the context of these purchasing groups—that is, to the extent both parties’ watches may include luxury or expensive watches, the strength of Opposer’s mark and its degree of recognition in this segment of market weighs in favor of finding confusion likely. As to the general watch market, which may include relatively inexpensive or moderately-priced

watches, the factors involving the strength or weakness of Opposer's mark remain neutral.

C. Similarity of the Marks

We turn now to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.") (citation omitted).

We also keep in mind that the degree of similarity between the marks necessary to find a likelihood of confusion declines where, as here, the marks will be used on identical goods, i.e., watches, and offered in the same trade channels to the same class of consumers for watches. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (TTAB 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed Cir. 2010); *Max Capital*, 93 USPQ2d 1248.

In comparing the Opposer's mark, ROYAL OAK, with Applicant's marks, MOSSY



OAK and **MOSSY OAK**, there is the obvious point of similarity in that they share the term OAK. Both marks also begin with a two-syllable adjective. As for points of

difference, the initial words in each mark, ROYAL and MOSSY, have very different meanings and are visually and aurally different. There is also the design element in Applicant's second mark.

Opposer argues that the marks are similar because "OAK is the dominant feature of the marks, and ROYAL and MOSSY are just adjectives which modify the noun OAK."⁶³ Opposer asserts that the differences between the parties' marks are less important:⁶⁴

The MOSSY portion of applicant's marks does not serve to distinguish applicant's marks from opposer's marks, because mossy-ness is a common characteristic of trees including oak trees. The tree image in applicant's MOSSY OAK design mark also does not serve to distinguish that mark from opposer's marks, because when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and be used in calling for the goods or services.

Applicant argues that, despite sharing the term OAK, the marks are very different:⁶⁵

The commercial impression of the two marks could not be more different. The only similarity between the marks is the common term "oak." The adjective accompanying each mark renders totally different impressions: ROYAL OAK evokes a regal, expensive, crisp, stately and elaborate atmosphere. MOSSY OAK, on the other hand, evokes an outdoorsy, swampy atmosphere. Thus, the commercial impression and connotation are indeed dissimilar.

We agree with Applicant, inasmuch as already stated, the initial terms in each mark, ROYAL and MOSSY, have different meanings. On the other hand, we agree

⁶³ 129 TTABVUE 11.

⁶⁴ *Id.* at 12.

⁶⁵ 130 TTABVUE 14-15.

with Opposer to the extent that the same term, OAK, is the object of these adjectives and is not weak in the field of watches. We further agree with Opposer that the tree in an oval design in Applicant's composite mark does little to distinguish the marks—as a tree, it helps reinforce or put emphasis on the OAK element of the mark.

Moreover, because Opposer's marks are strong and the goods are identical, consumers may perceive Applicant's marks as designating a product line extension of Opposer's watches. See *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009); (VANTAGE TITAN “more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices”); *Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant's mark is a variation of opposer's mark that opposer has adopted for use on a different product.”). In other words, consumers already familiar with Opposer's ROYAL OAK watches may mistakenly believe that MOSSY OAK is a separate line or extension of watches with a different purpose or being offered at a different price point.

Overall, we find the marks are more similar than not and this factor weighs slightly in favor of finding confusion likely. In making this finding, we, again, keep in mind that the degree of similarity between the marks necessary for finding confusion likely is lessened here in view of the parties' in part identical goods being offered in the same trade channels to the same class of consumers. *In re Viterra*, 101 USPQ2d

at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital*, 93 USPQ2d at 1248.

D. Lack of Instances of Actual Confusion; Opportunity for Confusion

We now address the seventh *DuPont* factor, the “nature and extent of any actual confusion,” and the related eighth *DuPont* factor, the “length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *DuPont*, 177 USPQ at 567. In assessing these factors, we are required “to look at actual market conditions, to the extent there is evidence of such conditions of record.” *In re Guild*, 2020 USPQ2d at *6. *See also In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971). The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Applicant of its mark for a significant period of time in the same markets as those served by Registrant under its marks. *Citigroup, Inc. v. Cap. City Bank Group*, 94 USPQ2d 1645, 1660 (TTAB 2010); *Gillette Can. Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the

likelihood of confusion is only a remote possibility with little probability of occurring.”).

Applicant, in arguing these factors, relies on Opposer’s discovery responses to interrogatories wherein Opposer acknowledges that it is unaware of any instances of actual confusion.⁶⁶ Indeed, Applicant states that, despite the almost twenty years of concurrent use of the ROYAL OAK and MOSSY OAK marks for watches and/or jewelry, **neither party can point to a single instance of actual confusion between the marks.**⁶⁷ (Emphasis in original). Applicant further concludes that “[s]uch a remarkable fact is perhaps the strongest evidence that no likelihood of confusion exists between the marks.”⁶⁸

Opposer, on the other hand, relies on evidence to which Applicant has objected in arguing that “there is evidence of actual confusion here – or at the very least a strong potential for confusion.”⁶⁹ This evidence, to which Applicant objected to is unreliable for the purpose Opposer seeks to rely upon it and, in any event, does not show actual confusion. Specifically, Opposer relies on printouts from the Walmart retail website purportedly depicting the results of searches for the terms “ROYAL OAK watch” and “MOSSY OAK watch,” and the cross-examination testimony of Applicant’s witness, Mr. Maki. However, Mr. Maki did not conduct any of the purported searches, and was

⁶⁶ 130 TTABVUE 41 (referring to Opposer’s response at 105 TTABVUE 17).

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ 129 TTABVUE 19.

merely asked to testify what the printouts show on their face. In other words, Mr. Maki is without personal knowledge as to the searches of the retail website, let alone how the website's search system produces results, e.g., any algorithmic factors. Moreover, the printouts or search results are not evidence of actual confusion. Rather, actual confusion contemplates evidence showing that consumers became confused as to the source of the parties' watches based on the marks. *See, e.g., Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975) (evidence showing an individual ordered a FINGA-MAGICS toy construction set, only to receive RINGA.MAJICS toy construction set instead and this single instance of actual confusion is "illustrative of how and why confusion is likely.")

Although we agree with Applicant that there is no evidence of actual confusion, we further note Opposer's argument that Applicant's MOSSY OAK-branded "watch ... business is extremely small, and always has been."⁷⁰ Opposer further posits, however, "[i]f the opposed marks are allowed to register and the MOSSY OAK watch ... business grows, that will no doubt increase the consumer confusion between" the parties' watches sold under their respective marks.⁷¹

We agree that there has been little demonstrated opportunity for confusion to have occurred. Rather, the record reflects that, although Applicant has sold or licensed MOSSY OAK-branded watches since 2004, the amount of sales of these watches has been intermittent and insignificant. Applicant's witness, Ms. Reed,

⁷⁰ 129 TTABVUE 20.

⁷¹ *Id.*

testified that it currently licenses to only two entities, Timex and Bertucci, with both beginning in 2019.⁷² Although there were previous licenses involving MOSSY OAK watches, they expired in the “mid 2000s to mid 20 teens” or “a long time ago.”⁷³ Ms. Reed acknowledges that before 2019, there was “probably a five-year period” in where there was no licensing.⁷⁴ Applicant does not state how many MOSSY OAK-branded watches have been sold since 2004, and the amount of “watch royalties paid to” Applicant can only be characterized as fairly insubstantial and, without more information that is not of record, we do not construe Applicant’s evidence of licensing its mark to others for watches as indicative of a large number of watches having been sold with the MOSSY OAK mark on them.⁷⁵

In sum, there is no evidence of actual consumer confusion and seventh *DuPont* factor remains neutral in our likelihood of confusion analysis. Likewise, there is insufficient evidence showing that any meaningful opportunity has existed for any actual confusion to have occurred, and thus the eighth *DuPont* factor also is neutral in our analysis.

⁷² 113 TTABVUE (Reed Dep. 7:6-17).

⁷³ *Id.*; Reed Dep. 7:18-25.

⁷⁴ *Id.*; Reed Dep. 89-19.

⁷⁵ 110 TTABVUE (Reed Dep. Ex. 4, designated “Confidential”);

E. Sophistication of Consumers

The fourth factor listed in *DuPont* is the “[i] conditions under which and [ii] buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.” 177 USPQ at 567 (brackets added). Under this factor, Applicant argues that Opposer’s watches are “prestige items and marketed through magazines directed toward high net worth individuals.”

Again, Applicant’s applications and Opposer’s registration list “watches,” without any restriction, and the presumption that these include all types of watches in all trade channels also applies to classes of customers. *See, e.g., Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002). In other words, we must anticipate that both Applicant’s and Opposer’s watches will be offered for sale to all classes of consumers for watches at all possible price points. Specifically, although the evidence shows that Opposer’s ROYAL OAK watches retail for “around \$20,000.00,” with some selling for significantly higher amounts,⁷⁶ Opposer’s identification of goods encompasses watches at all price points. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). Similarly, although Applicant’s witness testified that its MOSSY OAK watches may sell for as

⁷⁶ 92 TTABVUE (Rohr Dep. 62:7-11).

low as \$19.99,⁷⁷ we cannot restrict Applicant's watches to this lower price, but must consider the possibility that Applicant's watches will be sold in the luxury watch market.

Nevertheless, because we find Opposer's ROYAL OAK is an especially strong mark with "niche fame" in the luxury brand watch market, we agree with Applicant that consumers in this particular segment of the watch market exercise greater degree of care in their purchasing decisions. *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *4 ("[I]n light of the inherent nature of the **goods** and services involved, some degree of purchasing care may be exercised by Applicant's potential or actual consumers.") That is, we can presume that a consumer spending more than \$20,000 on a watch will spend more time in deciding to purchase such an item and, in this particular luxury watch market, the fourth *DuPont* factor weighs against the likelihood that consumers may be confused.

In the context of all other watches and particularly those that fall within the lower price brackets, or below \$20 per item, we cannot assume any elevated degree of consumer care in purchasing selection. Rather, we must base our decision on the least sophisticated potential purchasers. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion*, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516 (Fed. Cir. 2019) (recognizing Board precedent requiring consideration of the

⁷⁷ 101 TTABVUE 5, 15 (Reed Decl. page 2; Reed Ex. C).

“least sophisticated consumer in the class”). In other words, the fourth *DuPont* factor remains neutral in connection with these lower-priced or mid-range watches.

F. Other Factors Argued

Applicant argues several other *DuPont* factors; however, these arguments are misplaced or not supported by the record. In particular, Applicant argues the ninth *DuPont* factor, which takes into account the variety of goods or services offered by a prior user. 177 USPQ 567. Applicant argues that this issue is “(tellingly) not addressed by Opposer,” but that because Applicant’s mark MOSSY OAK is “a well-known house mark of the Applicant and has been used on a wide variety of products by over 700 licensees” and that “[f]or this reason, the public recognizes and associates MOSSY OAK with an outdoor lifestyle and hunting company, totally unrelated, and in a different field from, AUDEMARS PIGUET and its ROYAL OAK mark.”⁷⁸ However, this factor is, in essence, used for purposes of showing a relatedness of the goods and because the parties’ goods are identical in this case, there is no need to rely on this factor. *See Made in Nature*, 2022 USPQ2d 557, at *60 (“Given the relatedness of the parties' identified goods, we find it unnecessary to rely on this factor. We therefore find the ninth *DuPont* factor to be neutral with respect to a finding of likelihood of confusion.”); *Monster Energy v. Lo*, 2023 USPQ2d 87, at *39 (TTAB 2023) (“This factor may favor a finding that confusion is likely if the goods or services are not obviously related, but has less impact if the parties' goods or services in issue are

⁷⁸ 130 TTABVUE 43-44.

identical or closely related.”). Accordingly, we find the ninth *DuPont* factor neutral in our analysis.

Applicant also relies on the tenth *DuPont* factor, which requires us to consider evidence pertaining to the “market interface” between the parties, including evidence of any past dealings between the parties which might be indicative of a lack of confusion. 177 USPQ 567. Here, Applicant argues this factor favors a finding of no likelihood of confusion because “the only interface between the Applicant and Opposer is a total lack of interface between the two, even over the twenty-year period of which both marks were concurrently used for watches and/or jewelry.”⁷⁹ However, because there is no evidence that the parties have had any past dealings, as Applicant acknowledges, this *DuPont* factor is also neutral. *Cunningham*, 55 USPQ2d at 1847.

Finally, Applicant puts forth arguments under the eleventh and twelfth *DuPont* factors, without pointing to any evidence of record. That is, in asserting the eleventh *DuPont* factor, Applicant contends that “Opposer has a pattern and practice in bullying those smaller entities that do not have the desire, willpower, or financial resources to challenge Opposer’s bluff,” and Opposer “has no right to exclude others from use of any mark containing the ‘oak’ term’.”⁸⁰ On its face, the eleventh factor, ‘the extent to which applicant has a right to exclude others from use of its mark on its goods,’ involves an applicant’s, and not an opposer’s, right to exclude other users. *Monster Energy v. Lo*, 2023 USPQ2d at *43 n. 80. Moreover, attorney argument is no

⁷⁹ 130 TTABVUE 44.

⁸⁰ 130 TTABVUE 45.

substitute for evidence. *Cai*, 127 USPQ2d 1799. Similarly, in arguing the twelfth *DuPont* factor, involving the extent of potential confusion, Applicant repeats arguments previously made and pertinent to other factors and concludes that “[i]n no event would the extent of potential confusion be actual or substantial.”⁸¹ (emphasis in original). We are not persuaded by the arguments and, in the absence of any relevant evidence, do not find this factor weighs against a finding that confusion is likely. Accordingly, the eleventh and twelfth *DuPont* factors are neutral in our analysis.

V. Likelihood of Confusion -- Conclusion

Opposer’s mark, ROYAL OAK, and Applicant’s marks, MOSSY OAK in standard characters and stylized with design, are overall more similar than not. The marks’ shared term, OAK, has not been demonstrated to be weak, either conceptually or commercially, in connection with watches. Because these similar marks are used on identical goods, i.e., watches, and the watches are offered through the same channels of trade to all classes of customers, from consumers of inexpensive watches to those looking to purchase expensive luxury watches, we ultimately find confusion is likely.

In reaching our ultimate decision, we reviewed and considered all evidence of record in connection with all other relevant *DuPont* factors. Particularly, we found that Opposer’s ROYAL OAK is an extremely strong mark, has niche fame, in the luxury watch market, but this significance is tempered by our finding that consumers

⁸¹ 130 TTABVUE 45.

of luxury watches are likely to exercise a higher level of care in making their purchasing decisions. *See HRL Assoc., Inc. v. Weiss Assoc., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods).

We also keep in mind our finding that, in the overall watch market that includes inexpensive or moderately priced watches, Opposer's ROYAL OAK is a commercially strong mark, with no demonstrated weakness. It is at least entitled to a normal scope of protection. Consumers in this segment of the market will not necessarily exercise any higher level of care in making their purchases, especially if the watches are in the lower price range.

Again, weighing these findings, we ultimately conclude that there is a likelihood of confusion between the parties' marks.

Decision: The opposition is dismissed as to Applicant's two applications on the ground of dilution.⁸² However the opposition is sustained as to Applicant's two applications on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.

⁸² *See* Note 62.